

REMARKS

Claims 1-8 and 21-27 are pending. The Office Action dated August 2, 2002 has been carefully considered. Applicant appreciates that the Examiner has allowed Claims 3-6 and 21-27. Applicant requests that the Examiner consider the following remarks, and pass the application to allowance.

Response to Finality of Action:

In a telephone conference with Examiner Maynard on September 17, 2002, Cindy Lynch, an attorney for applicant, requested that the finality of the Office Action dated August 2, 2002 be withdrawn. Examiner Maynard requested that the reasons for withdrawal of the finality be set forth in this response.

The Office Action dated August 2, 2002 was improperly made final because the response dated June 17, 2002 did not necessitate the new grounds of rejection. Specifically, the response canceled rejected Claims 9-16, rewrote Claim 3 in independent form, and brought the declaration to swear behind Harmon (originally filed on July 19, 2001) to the Examiner's attention. None of these actions in the response necessitated the new rejection. Accordingly, Applicant requests that the finality of the rejection be withdrawn.

Response to Claim Objections:

Claim 17 was objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 17 has been canceled without prejudice or disclaimer of the subject matter contained therein.

Response to 35 U.S.C. § 102(b) Rejections:

Claims 1, 2, 8 and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kercso (U.S. Patent No. 4,105,030 A).

Claim 1 recites a trocar. The trocar includes a cannula for receiving an implant and inserting the implant into an animal, the cannula having a sharp tissue penetrating distal end; a spring element received entirely within the cannula, the spring element having a leaf spring for retaining the implant inside the cannula, the leaf spring applying a frictional force against the implant sufficient to prevent the implant from sliding out of the cannula under a weight of the implant; and an obturator for delivering the implant from the cannula into the animal. (Emphasis added.)

Kercso relates to an implant apparatus for implanting drug-containing pellets in animals. The apparatus includes a handle to grasp the apparatus, a track attached to the handle and suitable for a carriage, and a carriage placed within the track. The carriage has a means in the front part of the carriage to receive and retain a detachable needle. The detachable needle 50 is "an elongated tube or barrel 52 having an enlarged portion 60 and a sharp, beveled end 56." Col. 5, lines 33-36. "The pellets are retained in passageway 54 by covering the rear of the passageway with a removable tape and downwardly extending flexible finger 55 which is attached to barrel 52 and is pushed aside by the pressure of retraction." Col. 5, lines 60-64. The flexible finger 55, however, as shown in FIG. 4E is not received entirely within the passageway. Rather, a portion of the flexible finger is received outside of the passageway as a result of the "sharp, beveled end 56." In addition, Kercso does not teach or suggest a spring element having a leaf spring for retaining the implant inside the cannula. Rather, Kercso has a "flexible finger 55". Accordingly, since Kercso does not teach or suggest a spring element received entirely within the cannula, and the spring element having a leaf spring for retaining the implant inside the cannula, Claim 1 should be allowable. Claims 2 and 8 are dependent from Claim 1 and should also be allowable.

Response to 35 U.S.C. § 103(a) Rejections:

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kercso (U.S. Patent No. 4,105,030 A).

Claim 7 recites the trocar according to claim 1, wherein the obturator has a tapered distal end to prevent ejection of the spring element from the cannula when the obturator is moved distally to eject the implant from the cannula. Since Kercso does not teach or suggest a spring element received entirely within the cannula and the spring element having a leaf spring for retaining the implant inside the cannula, Claim 7 should be allowable.

In addition, Applicants traverse the Examiner's statement that it "would have been obvious to have provided Kercso's obturator (28) with a gently tapered distal end so as to facilitate smooth entry of the obturator into the proximal end of the cannula/tube 150." Applicants request that the Examiner cite a reference in support of this position or withdraw the rejection.

CONCLUSION

It is respectfully submitted that Claims 1-8 and 21-27 are presently in condition for immediate allowance, and such action is requested. If, however, any matters remain that could be clarified by Examiner's Amendment, the Examiner is cordially invited to contact the undersigned by telephone at the number below.

Respectfully submitted,

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